

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-23 are pending in the present application. Claims 11-18 are withdrawn from consideration, and Claims 19-23 are amended by the present amendment.

In the outstanding Office Action, Claims 19-23 were rejected under 35 U.S.C. § 101; and Claims 1-10 and 19-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bhaskaran et al. (U.S. Patent 6,157,915, herein "Bhaskaran") in view of Thackston (U.S. Patent 6,295,513).

Claims 19-23 were rejected under 35 U.S.C. § 101. Applicant amended Claims 19-23 to recite statutory subject matter, and that Claims 19-23 are believed to overcome the rejection under 35 U.S.C. § 101. Accordingly, Applicant respectfully requests the withdrawal of this rejection.

Before treating the outstanding art based rejection, it is believed that a brief review of the present invention would be helpful. The present invention relates to an apparatus of Claim 1, a computer program of Claim 6, and a computer implemented method of Claim 19 for assisting a placing an order for manufacturing a semiconductor device. One of the benefits of the claimed "apparatus," "computer program," and "computer implemented method" is that it allows a semiconductor device developer to efficiently select makers that meet specifications of a semiconductor device to be developed, and provide skills and technologies needed to develop the semiconductor device (i.e. the introducing unit including a retrieving unit of Claim 1, the function configured to introduce and including a function configured to retrieve of Claim 6, and the introducing step including a retrieving step of Claim 19, for example). Therefore, the developer is able to develop the semiconductor

device in a short amount of time with low risk and costs (see also the specification at page 9, line 36 to page 10, line 13, for example).

Turning to the rejection of Claims 1-10 and 19-23 under 35 U.S.C. § 103(a) as unpatentable over Bhaskaran in view of Thackston, as stated in the Office Action, Bhaskaran fails to disclose or suggest the “introducing unit that includes a retrieving unit” of Claim 1, the “function configured to introduce and including a function configured to retrieve” of Claim 6, and the “introducing step including a retrieving step” of Claim 19 (see also page 4, second paragraph, of the Office Action).

The Office Action then relies on Thackston in an attempt to remedy the above deficiencies of Bhaskaran (see also page 4, third paragraph, of the Office Action). Applicant respectfully submits that Thackston does not remedy these deficiencies of Bhaskaran, for the following reasons.

Initially, the Office Action states that it would have been obvious to one skilled in the art to provide an apparatus for managing supply chains of Bhaskaran with the searchable Global Manufacturer’s Registry (GMR) of Thackston “in order to have a completed supply chain for production/manufacturing a product, which includes selected maker groups for various components” (see also page 5, lines 1-15, of the Office Action).

The record, however, fails to provide the required *evidence* of a motivation for a person of ordinary skill in the art to provide the apparatus of Bhaskaran with the GMR of Thackston. While Thackston may provide a reason for using the GMR in undertaking an engineering design project, Thackston fails to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature of the GMR in an apparatus for managing supply chains such as the one disclosed in Bhaskaran.

See M.P.E.P. 2143.01 stating “[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also M.P.E.P. 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

Note further that the case law requires the PTO to set forth "a full and reasoned explanation" (In re Lee, 61 USPQ2d 1430, 1432 (Fed. Cir. 2000), and to establish a reason why the artisan would even select such disparate reference for combination in the first place. See In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

For example, Thackston uses the GMR to identify qualified fabricators for the engineering design project based on fabricator capability information stored in the GMR (see the abstract, column 36, lines 42-58, column 38, lines 39-54, and Figures 20 and 21). Thackston, however, does not suggest that the GMR would work in an apparatus for managing supply chains, much less "[in order to have] achieve a completed supply chain for production/manufacturing a product"

In addition, Bhaskaran does not suggest that further improvement is desired, nor that another feature should be added to the apparatus for managing supply chains "[in order to have] to achieve a completed supply chain for production/manufacturing a product" In particular, Bhaskaran does not suggest adding the GMR, such as the one disclosed in Thackston.

Therefore, Bhaskaran and Thackston do not provide the motivation to perform the proposed modification of the Bhaskaran's apparatus. In other words, an attempt to bring in the isolated teaching of Thackston into the Bhaskaran's apparatus would amount to improperly picking and choosing features from different references without regard to the

teachings of the references as a whole. See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.") While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.¹ In this case, the record fails to support the proposed modification of the Bhaskaran's apparatus.

Furthermore, it is not clear from the record how the GMR of Thackston could be incorporated into the Bhaskaran's apparatus. Under the proposed modification, the complex interconnections of different modules in the Thackston's GMR system would necessitate a substantial reconstruction or complete redesign of the Bhaskaran's apparatus, and would change the basic principle of operation of the Bhaskaran's apparatus. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign. Furthermore, it is not clear from the record whether such modification would actually "[in order to have] achieve a completed supply chain for production/manufacturing a product"

It is respectfully submitted that the USPTO must support its rejection by "substantial evidence" within the record,² and by "clear and particular" evidence³ of a suggestion,

¹ In re Lee, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

² In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying the Bhaskaran's apparatus by incorporating the Thackston's GMR. Without such motivation and absent improper hindsight reconstruction,⁴ a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-10 and 19-23 are believed to be non-obvious and patentable over Bhaskaran and Thackston, and the above-noted benefits obtained from the "apparatus," "computer program," and "computer implemented method" as recited in Claims 1, 6 and 19, respectively, are not obviated.

Consequently, in light of the above discussion, and in view of the present amendment, Applicant respectfully submits that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

EHK/GS:mda
I:\ATTY\GS\21S\210608\AME 2.DOC

³ In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.") (emphasis added).

⁴ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."